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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,495	12/09/2003	Craig E. Mitchell	C-7223	4625

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EXAMINER	
YOON, TAE H	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/731,495	MITCHELL ET AL.	
	Examiner	Art Unit	
	Tae H. Yoon	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) *1-25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-25, drawn to a method of making an aqueous concentrate, classified in class 528, subclass 480+.

II. Claims 26-35, drawn to an aqueous concentrate, classified in class 524, subclass 100+ and 803.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product can be made by mixing an aqueous solution of polyvinyl alcohol and moist filter cake containing a brightener as taught by example 1 of US Pat. 6,620,294.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with Ms. Spiering on August 10, 2006 a provisional election was made with traverse to prosecute the invention of Group II,

claims 26-35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 26-28 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jokinen et al (US 6,620,294).

Jokinen et al teach the instant aqueous polyvinyl alcohol composition containing fluorescent whitening agent in abstract and examples. Mowiol 3-98, 4-98, 6-98, 4-88 and5-88 in examples 9 and 8 inherently meet the instant polyvinyl alcohol and hydrolysis thereof.

Thus, the instant invention lacks novelty.

Claims 26-28 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jokinen et al (US 6,620,294).

The examiner takes a position of Judicial Notice. Mowiol Technical Data Sheet by Kararay Specialties Europe, 1998.shows that Mowiol 3-98, 4-98, 6-98 and 4-88, and 5-88 have hydrolysis degree of 87.7 $\pm$ 1.0 and 98.4 $\pm$ 0.4, respectively, supporting the above examiner's position.

Thus, the instant invention lacks novelty.

Claims 26-28 and 30-34 are rejected under 35 U.S.C. 103(a) as obvious over Jokinen et al (US 6,620,294) in view of Takao et al (US 5,753,589).

The instant invention further recites stilbene brightener over fluorescent whitening agents of Jokinen et al. However, the instant stilbene fluorescent whitening agents are well known in the art as taught by Takao et al, col. 4, lines 16-65.

It would have been obvious to one skilled in the art at the time of invention to utilize stilbene fluorescent whitening agents of Takao et al in Jokinen et al since Jokinen et al teach using fluorescent whitening agents and since the instant stilbene fluorescent whitening agents are well known in the art absent showing otherwise.

Claims 26-28 and 30-34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takao et al (US 5,753,589).

Takao et al teach the instant aqueous polyvinyl alcohol composition containing fluorescent whitening agent of stilbene brightener in abstract and examples 1 and 3-6. Polyvinyl alcohol has a degree of saponification from 70 mol% up to 100 mol% (col. 3, lines 30-33). Polyvinyl alcohol in said examples 1 and 3-6 inherently has the instantly recited viscosity.

Thus, the instant invention lacks novelty.

Claims 26-29 and 35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rohringer et al (US 5,830,241).

Rohringer et al teach the instant aqueous polyvinyl alcohol composition at col. 3, lines 2-5 and in examples 3-5. Polyvinyl alcohol taught at at col. 3, lines 2-5 inherently meets the instant viscosity

Thus, the instant invention lacks novelty.

Claims 26-35 are rejected under 35 U.S.C. 103(a) as obvious over Rohringer et al (US 5,830,241) in view of Takao et al (US 5,753,589).

The instant invention further recites stilbene brightener over fluorescent whitening agents of Jokinen et al. However, the instant stilbene fluorescent whitening agents are well known in the art as taught by Takao et al, col. 4.

It would have been obvious to one skilled in the art at the time of invention to utilize stilbene fluorescent whitening agents of Takao et al in Jokinen et al since Jokinen et al teach using fluorescent whitening agents and since the instant stilbene fluorescent whitening agents are well known in the art absent showing otherwise.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tae H Yoon
Primary Examiner
Art Unit 1714

THY/September 28, 2006